

81

1. (Four times amended) A process for reducing or eliminating the transfer or migration of a cosmetic, hygiene, or pharmaceutical composition, said process comprising introducing into said composition an emulsion comprising at least one α,ω -substituted oxyalkylenated silicone in an amount effective for reducing or eliminating the transfer or migration of said composition, with the proviso that said emulsion does not contain clay.

REMARKS

Initially, Applicants wish to thank the Examiner and her supervisor, Examiner Padmanabhan, for the courtesies extended to the undersigned representative during the interview on February 10, 2003.

I. Status of the Claims

Claims 1, 3-60 and 62-67 are pending in the application. Claims 20-22, 24, 30-39, 41, 58, and 67 are withdrawn from consideration. Claim 1 has been amended to exclude clays from the emulsion. Support for the amendment can be found in the original specification, for example, at page 18, lines 3-7. Claim 1 has also been amended to address issues raised by the Office under 35 U.S.C. §112, second paragraph, by removing the phrase "when put to use." No new matter has been introduced by these amendments, nor do the amendments raise new issues or necessitate the undertaking of any additional search of the art by the Office.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

II. Rejection Under 35 U.S.C. § 112, Second Paragraph

The Office has rejected claims 1 and 3-11 under 35 U.S.C. § 112, second paragraph, as "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." (August 27, 2002, Office Action, page 2.) Applicants respectfully traverse this rejection at least for the reasons set forth below.

The Office has rejected the claims as indefinite because the "it is unclear what process Applicant[s] actually intend[] to claim." (Id.) As discussed during the interview, Applicants have amended independent claim 1, without prejudice or disclaimer, to remove the phrase "when put to use" and thereby render this rejection moot. Accordingly, Applicants respectfully request withdrawal of this rejection.

III. Rejections Under 35 U.S.C. § 102(b)

The Office has rejected claims 1-4, 8, 10, and 11 under 35 U.S.C. § 102(b) as anticipated by European Patent No. 0 331 833 A1 ("EP '833") for the reasons set forth on pages 2-3 of the outstanding Office Action. Applicants have amended independent claim 1 to exclude clays from the emulsion, as discussed during the interview, and therefore, respectfully submit that this rejection has been overcome.

As has often been made clear by the Federal Circuit, anticipation requires that each and every claim limitation be met by a single reference. See *Glaxo Inc. v. Novopharm, Ltd.*, 34 U.S.P.Q.2d 1565, 1567 (Fed. Cir. 1995). In the present case, the Office alleges that the "emulsions of the prior art contain the same components in the same amounts as instantly claimed." (February 26, 2002, Office Action, page 5.)

Applicants disagree, for at least the reasons of record, that EP '833 properly anticipates the invention. Nevertheless, solely in an effort to advance the prosecution of this case, Applicants have amended claim 1 to exclude clays from the emulsions.

Thus, as EP '833 does not contain all elements of the presently claimed invention, the reference cannot properly anticipate it. Accordingly, the rejection under § 102(b) should be withdrawn.

IV. Rejection Under 35 U.S.C. § 103(a)

The Office has rejected claims 1, 3-19, 23, 25-29, 40, 42-57, 59-60, and 60-66 under 35 U.S.C. § 103(a) as obvious over European Patent No. 0 373 661 A2 ("EP '661") in combination with European Patent No. 0 796 615 A1 ("EP '615") (U.S. Patent No. 6,074,633 ("633 patent") is the U.S. equivalent to this French language patent, and will be relied on in this paper). (August 27, 2002, Office Action, pages 3-4.) In addition to the reasons already of record, Applicants respectfully traverse this rejection for the reasons below.

In order to establish a *prima facie* case of obviousness, the Office must show that, *inter alia*, there is motivation to combine the references. M.P.E.P. § 2143. In the present case, however, there is no motivation to combine the references cited by the Office, and thus, a *prima facie* case of obviousness cannot be established.

First, acknowledging that EP '661 does not disclose an alpha, omega-substituted oxyalkylenated silicone, the Office attempts to cure this deficiency with the silicone compounds of EP '615. (August 27, 2002, Office Action, page 6.) The Office alleges

that "[i]t would have been obvious to one of ordinary skill in the art to substitute any one of the silicones of EP '615 for another [in EP '661] expecting the same results." (Id.)

EP '661, however, does not teach or suggest that the silicones disclosed therein could be substituted with any α,ω -substituted oxyalkylenated silicones, let alone the specific α,ω -substituted oxyalkylenated silicones of claims 1 and 12. In fact, EP '661 teaches away from such a substitution when it states that it is "very difficult to obtain a highly stable water-in-oil type emulsion cosmetic which comprises a silicone oil as a base." See EP '661, page 2, lines 27-29. Moreover, the '633 patent similarly states that "efficiently keeping insoluble agents in suspension" is "a difficult problem to solve." See '633 patent, col. 1, lines 37-39. In light of the teachings in EP '661 and the '633 patent, the Office's proposed combination would not have been obvious to one of ordinary skill in the art at all. In fact, in light of these teachings, the skilled artisan would likely have felt that such a combination would not have been successful.

Second, EP '615 relates to a "detergent cosmetic composition." See '633 patent, claim 1. In contrast, EP '661 relates to a water-in-oil cosmetic composition. See EP '661, page 2, line 4. One of ordinary skill in the art would not have been motivated to substitute elements of these compositions, intended for two different and completely incompatible uses. Specifically, EP '661 is directed to water-in-oil emulsions for treating and making up the skin, such as lotions and foundations. In stark contrast, the '633 patent is directed to detergent compositions, such as shower gels and shampoo. In other words, the compositions of the '633 patent are actually useful for removing the compositions of EP '661 as applied according to their intended use. Thus, the skilled artisan would not have been motivated to combine these references, as she would have

realized that the intended use of the composition according to one disclosure would destroy the intended use of the composition according to the other disclosure.

Thus, in light of the fact that (1) the express teachings of the references themselves would actually discourage the combination the Office proposes, and (2) the use of a composition according to one reference would destroy the intended use of a composition according to the other reference, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness of this combination. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

V. Conclusion

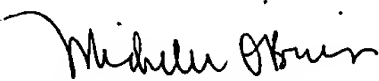
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 27, 2003

By: 
Michelle E. O'Brien
Reg. No. 46,203

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Attachment: Appendix to Amendment

APPENDIX TO AMENDMENT OF FEBRUARY 27, 2003
Version with markings to show changes made

IN THE CLAIMS:

Please replace claim 1 with amended claim 1, as follows:

1. (Four times amended) A process for reducing or eliminating the transfer or migration of a cosmetic, hygiene, or pharmaceutical composition ~~when put to use~~, said process comprising introducing into said composition an emulsion comprising at least one α,ω -substituted oxyalkylenated silicone in an amount effective for reducing or eliminating the transfer or migration of said composition ~~when put to use, wherein~~ with the proviso that said emulsion does not contain clay ~~has a dynamic viscosity ranging from 100 mPa.s to 20 Pa.s, this viscosity being measured on a Rheomat 180 from Mettler using a Spindle No. 2 at 25°C, at a shear rate of 200s⁻¹, and at time t=10 minutes.~~

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com